



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,932	01/25/2002	Anthony G. Martin	50642.00025	8366

30256 7590 03/18/2005

SQUIRE, SANDERS & DEMPSEY L.L.P
600 HANSEN WAY
PALO ALTO, CA 94304-1043

EXAMINER

HARTMAN JR, RONALD D

ART UNIT	PAPER NUMBER
----------	--------------

2121

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/056,932

Applicant(s)

MARTIN ET AL.

Examiner

Ronald D Hartman Jr.

Art Unit

2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/21/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-35 are presented for further examination.

Specification

2. The amendment filed on 1/4/2005 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "information related to rules presently stored at the client" and "zero or more rules", and this is further addressed below with regards to the pending 112 1st rejections set forth below in this office action.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specifically, claims 1, 9, 17, 25, 26, 27, 28 and 29 all recite "and information related to rules presently stored at the client" which is a feature not supported by the specification, as originally filed, and therefore these features appear to be new matter.

Also, claim 34 recites "zero or more rules" which is a feature not supported by the specification, as originally filed, and therefore these features appear to be new matter. The specification does not provide adequate support for zero rules.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-2, 4-10, 12-18, 20-27, 29-32 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoyle et al., PCT International Publication No. WO 00/04434.

As per claims 1, 9, 17, 25-27 and 29, Hoyle et al. teaches a method comprising:

- using a first application (e.g. corresponds to the client software application;

Figure 1 element 10) to obtain rule(s) for collecting information (Examiner's

Interpretation: "rules" is interpreted to mean any software means by which information is filtered or disseminated to a particular person, and this corresponds to the software which is downloaded into the client; page 10 lines 18-19) wherein the rule(s) are obtained in response to a request (e.g. corresponds to a download request; page 10 lines 18-19) that includes:

(1) an identifier associated with the client (e.g. page 10 lines 20-27 and page 18 lines 20-24); and

(2) information related to rules presently stored at the client (e.g. corresponds to upgrading software located on the client; page 18 lines 17-20);

- using the first application to monitor a second application on the client, the second application being in communication with a network wherein the second application is used for accessing sites on the network (e.g. page 27, line 31 – page 28, line 10;

- collecting information that satisfies a rule(s) using the first application (e.g. corresponds to collecting information about a user and storing a portion of the collected information on the client using the first application (e.g. corresponds to the use of the user data storage; Figure 1 element 34, for storing data about a user in conjunction with the ADM module so that appropriate banners may be downloaded via the network); and
- receiving content via the network for presentment by the first application based on the portion of the collected information stored on the client (e.g. corresponds to retrieving banners and placing them into banner storage; Figure 1 element 30, so that they may be retrieved and presented to the user, via the display; Figure 1 element 26, at a later time).

As per claims 2, 10 and 18, Hoyle further teaches the collected information being equivalent to behavioral information about a user (e.g. corresponds to computer usage information; page 16 L6-10).

As per claims 4, 12 and 20, Hoyle further teaches at least one rule(s) includes a trigger and when the trigger is tripped, a notification is transmitted to a location via the network (e.g. page 32, lines 25-28).

As per claims 5, 13 and 21, Hoyle further teaches that the rule(s) are obtained using the network (e.g. inherent to downloading software over the Internet; Figure 1).

As per claims 6, 14, 22, 26-27 and 29, Hoyle further teaches that the content includes additional rule(s) for controlling the presentment of the content (e.g. corresponds to category identifiers; page 32 lines 26-27).

As per claims 7-8, 15-16, 23-24, 26-27 and 29, Hoyle further teaches that a portion of the collected information is transmitted to a location using the network and that the information transmitted includes an identifier and wherein a portion of the received content is based on the identifier (e.g. corresponds to computer usage

information being transmitted to and stored by the ADM server; page 17 line 32 – page 18 line 14 and page 18 lines 16-25).

As per claim 30, Hoyle further teaches that the second application is a browser (e.g. page 4 line 26 – page 5 line 6; page 5 lines 10-11).

As per claim 31, Hoyle further teaches that the collected information includes information relating to a time at which the second application is used to access at least one site coupled to the network (e.g. corresponds to what time of day the computer is used; page 5 lines 22-24).

As per claims 26 and 32, Hoyle further teaches that the time information is used to determine an order of priority by which the content is presented (e.g. page 17 lines 23-25).

As per claim 34, Hoyle further teaches that the rule(s) are comprised of more than one rule (e.g. corresponds to more than one factor being utilized for determining advertisements; page 5, lines 22-24).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3, 11 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoyle et al., as applied to claims 1, 9 and 17 above, in view of obviousness.

As per claims 3, 11 and 19, a feature wherein the rule(s) are updated based upon the collected information pertaining to the behavior of the user is a feature that the disclosed system of Hoyle would obviously possess the capability of performing since the whole point of Hoyle is to allow for banner advertisements to target particular users based on their actions or desires while utilizing the Internet, and therefore since it is obvious that a users actions or desires change as a function of time, it would be obvious to allow for information to be collected, via use of rules, to also change or be updated as a function of the users ever changing preferences, thereby forming a more flexible banner collection service by providing the system with the ability to adapt to the ever changing preferences of a person, and this would have been obvious to one of ordinary skill in the art at the time the invention was made.

8. Claims 28, 33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoyle et al., in view of Krasnoiarov et al., U.S. Patent App. No. 2002/0156812.

As per claim 28, the rejection of claims 26 and/or claim 27 is applied equally herein.

Furthermore, Hoyle et al. does not specifically teach a table, per se, which is used to determine available content.

Krasnoiarov et al. teaches a list, which is a table of sorts, which lists the types of content components available from component servers and advertises these components to the users, wherein the lists are maintained based on the operations of the system (e.g. [0011], [0014] and [0038]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of a list or table for allowing an easy way of determining and maintaining information representative of the available content, and this would have been obvious to one of ordinary skill in the art at the time the invention was made.

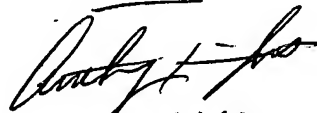
Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald D Hartman Jr. whose telephone number is (571) 272 - 3684. The examiner can normally be reached on Mon. - Fri., 11:30 am - 8:00 pm EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight can be reached at (571) 272 - 3687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ronald D Hartman Jr.
Patent Examiner
Art Unit 2121

X RDH



Anthony Knight
Supervisory Patent Examiner
Group 3600